

REMARKS

In the Office Action, the Examiner acknowledged receipt of the Amendment/Response filed February 6, 2006. Applicants thank the Examiner for the acknowledgment.

The Examiner then rejected Claims 1-6, 8-18, and 20 under 35 U.S.C. 102(b) as being anticipated by Zeidler et al (U.S. Patent No. 6,001,391). In response, Applicants respectfully request reconsideration and removal of this ground of rejection.

More particularly, Applicants aver that while every claim in the present application recites the use of an aminoketone antidepressant, Zeidler specifically excludes the use of an aminoketone antidepressant. Zeidler states that “[p]harmaceutical active ingredients mean for the purpose of the invention all substances with a pharmaceutical action **and minimal side effects...**” (Col. 5, lines 33-35) (emphasis added). However, bupropion (probably the most well-known aminoketone antidepressant) has been known to cause seizures, suicidal thoughts and actions, liver damage, psychosis, hallucinations, among other side effects.¹ These side effects are obviously not “minimal.” Additionally, the Zeidler patent does not mention aminoketones or bupropion, which are clear claim elements. The Examiner notes amitriptyline as an antidepressant mentioned by Zeidler; however, amitriptyline is a tricyclic antidepressant, not an aminoketone antidepressant.² Thus, Applicants’ claimed invention is not anticipated by Zeidler. Therefore, Applicants respectfully request removal of this ground of rejection.

¹ See Patient Information Sheet for Bupropion hydrochloride, *available at* <http://www.fda.gov/cder/drug/InfoSheets/patient/BupropionPT.htm>

² See Medline Plus Drug Information: Amitriptyline, *available at* <http://www.nlm.nih.gov/medlineplus/druginfo/medmaster/a682388.html>

The Examiner then rejected Claims 19, 21 and 22 under 35 U.S.C. 103(a) as being unpatentable over the disclosures of Zeidler et al (U.S. Patent No. 6,001,391). In response, Applicants respectfully request reconsideration and removal of this ground of rejection.

More particularly, Applicants aver that it would not be obvious to one of ordinary skill in the art to modify the teachings of Zeidler in such a way to create that which Applicants claim as the invention. One of the hallmarks of nonobviousness is when the prior art teaches away from that which is currently claimed. See *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (“a reference that teaches away is a significant factor to be considered in determining unobviousness...”); *Winner Intern. Royalty Corp. v. Wang*, 202 F.3d 1340, 1349-50 (Fed. Cir. 2000), *cert. denied*, 530 U.S. 1238 (2000) (stating that teaching away can be sufficient to defeat a claim of obviousness); *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (noting that there is an obviousness inquiry when a piece of prior art teaches away from a claimed invention); *see also* MPEP §2141.02. In this respect, Zeidler actively teaches away from using pharmaceutical active ingredients with serious side effects (Col. 5, lines 33-35) whereas Claims 19, 21 and 22 all recite the use of an aminoketone antidepressant (by virtue of their dependence from Claim 1). As detailed above, bupropion, probably the best known aminoketone antidepressant, can cause very serious side effects. Any person skilled in the art would understand that Zeidler forbids the use of aminoketone antidepressants (such as bupropion), which the present invention specifically claims. Thus, Zeidler can not render obvious Claims 19, 21 and 22. Therefore, Applicants respectfully request removal of this ground of rejection.

Applicants note that the Examiner responded to Applicants' prior arguments in Paragraph 9 of the Office Action and that the Examiner considered the arguments moot in view of the new grounds of rejection. Applicants thank the Examiner for removing the prior grounds of rejection.

Based on the above, Applicants respectfully submit that the claims of the present invention are in proper form for allowance. Favorable consideration and early allowance are therefore respectfully requested and earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. J. Solow', with a large, stylized loop at the end.

Matthew J. Solow
Reg. No. 56,878

MAILING ADDRESS

Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036
(212) 302-8989